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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/842,537	04/25/2001	Takuo Komai	29973-68355	7250

7590 04/06/2004

BARNES & THORNBURG
11 South Meridian Street
Indianapolis, IN 46204

EXAMINER

TRAIL, ALLYSON NEEL

ART UNIT	PAPER NUMBER
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2876

DATE MAILED: 04/06/2004

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

09/842,537

Applicant(s)

KOMAI, TAKUO

Examiner

Allyson N Trail

Art Unit

2876

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on December 22, 2003.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1 and 4-15 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1 and 4-15 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☒ All b) ☐ Some * c) ☐ None of:
- 1) ☒ Certified copies of the priority documents have been received.
 - 2) ☐ Certified copies of the priority documents have been received in Application No. _____.
 - 3) ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|--|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152) |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
Paper No(s)/Mail Date _____ | 6) <input type="checkbox"/> Other: _____ |

DETAILED ACTION

Amendment

1. Receipt is acknowledged of the Amendment filed December 22, 2003.

Claim Rejections - 35 USC § 103

2. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

3. Claims 1, 4-6, 8, 9, 11, 13, and 14 are rejected under 35 U.S.C. 103(a) as being unpatentable over Wellner (5,640,193) in view of Walsh et al (6,144,848).

Wellner teaches the following in regards to claims 1, 6, and 13 (for more of Wellner's teachings regarding claim 13 see below):

Figure 3 shows the process of the barcode reader. First a communication with a server is established, the user then swipes the paper with the barcode reader, the barcode information is then stored and the barcode reader transmits to the interfaces. Not shown in the figure is a data storing means identifying the specific barcode reading device. However, in the specification it is stated, "The memory may also store a scanner pen identification (ID) code to, for example, distinguish signals from different scanner pens which communicate with interface 15." (Cols. 2 and 3, lines 66-1).

Wellner teaches the following in regards to claims 4, 5, 9, and 14:

Figures 1 and 2 show a data output device 11 connected to a terminal 16 via a communications network 14. The data output device 11 is a scanner. The terminal 16

is later defined in claim 17 to be a television receiver and a multimedia computer. The information from the barcode is displayed on the terminal. Therefore the information must be accumulated in the host computer.

Wellner teaches the following in regards to claims 8 and 13:

"The interface unit 15 and television 16 may together be implemented in a well-known manner using, for example, a multimedia computer including a controller, memory, transmitter and receiver units, display unit, etc., so as to implement the features described herein." (Col. 3, lines 40-45).

Wellner teaches the following in regards to claim 11:

Claim 18 discloses the following: "scanning marks on an object to obtain information about the object itself, storing the scanned marks, converting the stored scanned marks into a request command including a first code identifying at least one video preview and a second code identifying a user's terminal". (Also see Wellner's teachings regarding claims 1 and 6 above).

Wellner's teachings above fails to teach the data output device being adapted to being connected to a mobile phone in an attachable/detachable manner.

Walsh et al however, teaches the above limitation.

Figure 5 shows a wireless phone 502. The user device 120 capable of reading barcodes (shown in figure 1A) is fastened to a cellular telephone, e.g. using an adapter enclosure 506 and an adapter interface 505 to couple the unit to the wireless telephone 502. The bar code reader 121 is fastened to enclosure 506 and has a bar code sensor 507 that protrudes from enclosure 506. Enclosure 506 also contains the

microprocessor, an optional audio mixer and amplifier, and telecommunication transceiver elements (defined above) of the subject user device. Bar code sensor 507 may be illuminated using a light-emitting diode. In optional embodiments, the bar code sensor 507 may be of the CCD type or single point source type, above. (See column 24, lines 4-30).

In view of Walsh et al's teachings it would have been obvious to one of ordinary skill in the art at the time the invention was made to use the barcode reading device taught by Wellner in combination with the barcode reading device (which included a cellular phone) taught by Walsh et al. Wellner uses a telephone line to communicate between the scanner and the server. Shown in figure 2 of Wellner is a stationary telephone used for communication. The scanner pen is used (in one embodiment) to skim through movie titles in order to send a request to order a movie to watch. With Wellner's invention, movies may only be ordered where existing phone lines are available. If the mobile phones taught by Walsh et al included the scanners taught by Wellner, the scanners could be useful in many different locations. One would be motivated to have the barcode scanner available on cellular phones in order to have more flexibility and to be able to use the scanners from any location.

4. Claims 7, 10, 12, and 15 are rejected under 35 U.S.C. 103(a) as being unpatentable over Wellner (5,640,193) in combination with Walsh et al (6,144,848) in further view of Komai (5,380,993).

Wellner's teachings in combination with Walsh et al's teachings are discussed above.

The combination of Wellner and Walsh et al fail to specifically teach the barcode being a micro barcode a thinnest black bar of which being approximately 100 μ m in width.

Komai teaches the following in regards to claims 7, 10, 12, and 15:

“In recent years, there have been developed technologies for printing bar codes on various media with substantially high precision and to read such bar codes. According to progress of the technology, the so-called micro-bar code, which is much smaller than typical available bar codes, is coming into practical use. The most thin black bar constituting the micro-bar code is 100 μ m width and about 1~10 mm in length.” (Col. 2, lines 10-17).

In view of Komai's teaching, it would have been obvious to an artisan of ordinary skill in the art at the time the invention was made to use a micro barcode as the barcode used by Wellner in combination with Walsh et al. Although Wellner and Walsh et al do not teach the specific type of barcode, the references do teach scanning a barcode on an item. Micro barcodes are well known in the art to take up little space on the object on which they are placed and therefore Wellner would have been motivated to use that type of barcode in the method for users to control the selection of electronic multimedia services in order to have numerous listings appear on one page.

Response to Arguments

5. Applicant's arguments with respect to claims 1 and 4-15 have been considered but are moot in view of the new ground(s) of rejection. The amended claims have been addressed with the teachings of Walsh et al.

Conclusion

6. The prior art made of record and not relied upon is considered pertinent to applicant's disclosure: Sanders et al (2002/0130184), Sizer et al (6,036,086), Miyake (6,029,892), Swartz et al (5,923,735), and Ishii et al (5,541,985)..

7. Applicant's amendment necessitated the new ground(s) of rejection presented in this Office action. Accordingly, **THIS ACTION IS MADE FINAL**. See MPEP § 706.07(a). Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the date of this final action.

8. Any inquiry concerning this communication or earlier communications from the examiner should be directed to *Allyson N. Trail* whose telephone number is (571) 272-2406. The examiner can normally be reached between the hours of 7:30AM to 4:00PM Monday thru Friday.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Michael G. Lee, can be reached on (571) 272-2398. The fax phone number for this Group is (703) 872-9306.

Communications via Internet e-mail regarding this application, other than those under 35 U.S.C. 132 or which otherwise require a signature, may be used by the applicant and should be addressed to [allyson.trail@uspto.gov].

All Internet e-mail communications will be made of record in the application file. PTO employees do not engage in Internet communications where there exists a possibility that sensitive information could be identified or exchanged unless the record includes a properly signed express waiver of the confidentiality requirements of 35 U.S.C. 122. This is more clearly set forth in the Interim Internet Usage Policy published in the Official Gazette of the Patent and Trademark on February 25, 1997 at 1195 OG 89.

Allyson N. Trail
Patent Examiner
Art Unit 2876
March 30, 2004

Jared J. Fureman
JARED J. FUREMAN
PRIMARY EXAMINER